



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Docket: ATM-2244

Applicants : Wilfried JUD et al.

Examiner: M. Jackson

Serial No. : 09/505,713

Art Unit: 177 A/E / 100M
#28 / (M8)
4-25-03

Filed : February 17, 2000

For : STERILIZABLE COMPOSITE FILM

AMENDMENT AFTER FINAL

Commissioner for Patents
Washington, D.C. 20231

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Dear Sir:

In response to the Office Action of February 24, 2003, applicants submit the following information and comments.

Claims 38 to 53 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Breitler et al. in view of Ulmann's Encyclopedia of Industrial Chemistry for the reasons cited in the prior Office Action and stated in detail in paragraph 4 of Paper No. 11. Applicants traverse this rejection.

Section 103(a) requires facts, not speculation. As the Examiner stated on page 4 of the Office Action, she is relying on "her interpretation" and that Breitler et al. "can be interpreted in two ways". While applicants disagree that there are two ways to interpret Breitler et al., the Examiner has not established in the record anything but speculation. Choice between two so-called interpretations is certainly not the establishment of facts required by Section 103(a). The Examiner has not even shown or established factually in the record why one ordinarily skilled in the art has motivation or reason to choose her interpretation as opposed to any other interpretation. Of course, to even suggest that one can

choose between two "interpretations" has nothing to do with the requirements of Section 103(a).

Page 2100-112 of the M.P.E.P states:

"2141 35 U.S.C. 103; the Graham Factual Inquiries"

Page 2100-113 of the M.P.E.P. states:

"Office policy is to follow *Graham v. John Deere Co.* in the consideration and determination of obviousness under 35 U.S.C. 103. As quoted above, the four factual inquires enunciated therein as a back-ground for determining obviousness are as follows:

(A) Determining the scope and contents of the prior art;

(B) Ascertaining the differences between the prior art and the claims in issue;

(C) Resolving the level of ordinary skill in the pertinent art;

and

(D) Evaluating the evidence of secondary considerations."

"The Supreme Court reaffirmed and relied upon the *Graham* three pronged test in its consideration and determination of obviousness in the fact situations presented in *Sakraida v. Ag Pro, Inc.*, 425 U.S. 273, 189 USPQ 449, *reh'g denied*, 426 U.S. 955 (1976) and *Anferson's-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57, 163 USPQ 673 (1969). In each case, the Court discussed whether the claimed combinations produced a "new or different function" and a "synergistic result," but it clearly decided whether the claimed

inventions were nonobviousness on the basis of the three-way test in *Graham*. Nowhere in its decisions in these cases does the Court state that the "new or different function" and "synergistic result" tests supersede a finding of nonobvious or obviousness under the *Graham* test."

"Accordingly, examiners should apply the test for patentability under 35 U.S.C. 103 set forth in *Graham*." [Emphasis supplied]

Page 2100-113 of the M.P.E.P. states:

"STANDARD OF PATENTABILITY TO BE APPLIED IN OBVIOUSNESS REJECTIONS"

"Patent examiners carry the responsibility of making sure that the standard of patentability enunciated by the Supreme Court and by Congress is applied in each and every case. The Supreme Court in *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966),"

"Patent examiners carry the responsibility of making sure that the standard of patentability enunciated by the Supreme Court and by the Congress is applied in each and every case. The Supreme Court in *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966)."

The Examiner has not followed the dictated procedure and requirements of the Graham decision.

In the Office Action of December 19, 2001, Paper Number 11, the Examiner first made a Section 103(a) rejection based on Breitler et al. in view of Ullmann's Encyclopedia of Industrial Chemistry. In the obviousness rejection of the present Office Action, the Examiner referred to paragraph 4 of Paper Number 11. Such paragraph 4 and the subsequent Advisory and Office Actions are devoid of mention of, for example, the numerical ranges in applicants' claims and the rejection references. The Examiner has not factually in the record, for all of applicants' claims, (a) determined the scope and content of the prior art and (b) ascertained the difference between the prior art and the claims in issue. The Examiner has not followed requirements (a) and (b) of the Graham decision.

Accordingly, the obviousness rejection is fatally defective. Furthermore, the Examiner cannot have factually established in the record any *prima facie* showing of obviousness.

Likewise, there is no mention of or resolution of the level of ordinary skill in the pertinent art, or mention of the facts to be used to make such resolution. The Examiner has not followed requirement (c) of the Graham decision.

For this further reason, the obviousness rejection is fatally defective. The Examiner has not factually established in the record any *prima facie* showing of obviousness.

The Examiner has not followed the requirements of the Graham decision in making the obviousness rejection and therefore has not followed Office policy. The obviousness rejection is defective on its face. Applicants request that the final status of the obviousness rejection (and the entire Final Rejection) be

withdrawn. Any new Office Action containing an obviousness rejection should follow the Grahams decision requirement.

The Examiner has not carried the Examiner's burden of proof under Section 103(a). The Examiner has not produced a *prima facie* case of obviousness, so the burden of proof has not been shifted to the applicants.

This rejection should be withdrawn.

Claims 38 to 53 have been rejected under 35 U.S.C. 102(b) as being anticipated by Breitler et al. (U.S. Patent No. 5,589,275) for the reasons recited in the prior Office Action and stated in detail in Paragraph 3 of Paper No. 11. Applicants traverse this rejection.

Section 102(b) requires facts, not speculation. Page 2100-69 of the M.P.E.P. states:

"A claim is anticipated only if each and every element as set forth in the claims is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)."

The Examiner has stated that the Examiner has selected one of two interpretations of Breitler et al. The Examiner has used speculation by selecting one of two so-called interpretations, whereas facts are required. Webster's Seventh New Collegiate Dictionary, (1963), states:

"fact...3: the quality of being actual" [Page 298]

"interpret...2: to conceive in the light of individual belief, judgment, or circumstances" [Page 443]

Interpretation is not a fact(s), which is (are) required by Section 102(b). The Examiner has not carried the Examiner's burden of proof.

The Examiner has the burden of proving that the Examiner's reading of Breitler et al. is the only possible reading of such reference. Any prior art disclosure that can be read two or more ways does not establish the required factual basis. Applicants do not agree that there are two possible so-called interpretations of Breitler et al. The Examiner's so-called interpretation of Breitler et al. is in error and unsupportable, as applicants have earlier shown.

The Examiner has not produced a sustainable or *prima facie* showing of anticipation supported by facts in the record. Hence, the anticipation rejection is fatally flawed.

This rejection should be withdrawn.

Reconsideration, reexamination and allowance of the claims are requested.

Respectfully submitted,

April 23, 2003
Date

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